

REMARKS/ARGUMENTS

Claims 17-38 are pending in the application. Claims 17-36 are amended, and Claims 37 and 38 are newly added. The amendments to the claims as indicated herein do not add any new matter to this application. The various issues within the Office Action will now be addressed in order of appearance.

Claims 17, 18, 20-23, 25-27, 29-32, and 34 continue to stand rejected under 35 U.S.C. § 102 as being allegedly anticipated by U.S. Patent No. US 7,076,443 B1 to Emens (Office Action, Page 2, Sections 3-4). The Office Action does not state which subsection of 35 U.S.C. § 102 is used in the rejection, and appears to accidentally refer to 35 U.S.C. § 102(2) but Applicant believes 35 U.S.C. § 102(e) was intended. Regardless of which section is used, this rejection is respectfully traversed.

Claims 17 and 26 have been amended. Both claims now recite, among other things,

... selecting a set of sponsored content to integrate into information generated for display to said user by a non-search application;

wherein the set of sponsored content is selected based, at least in part, on said user specific data; and

integrating said set of sponsored content within said information;

wherein said non-search application is one from a group consisting of: an email client, an instant messaging client, and a website other than said search website.

The Office Action (page 2, bottom paragraph) asserts that Applicant's claimed step of integrating said sponsored content into "a display generated by a website other than said search websites" is anticipated by Emen's "banner advertising . . . placed on popular websites", col. 1 lines 18-21. Emen's banner advertising is not anywhere described as being selected "based, at least in part, on user-specific data", as claimed.

Indeed, Emen goes on to disparage banner advertisements in general, and suggest why banner ads don't work, stating "banner . . . advertisements are made available to the user **whether or not these ads have been specifically solicited**" (Emen, col. 1, lines 22-25, emphasis added), which would suggest that Emen's banner ads were not selected based on user specific data. Thus, the Office Action is inconsistent regarding its own interpretation of the Emen reference.

In sharp contrast, Claims 17 and 26 recite, inter alia, "selecting a set of sponsored content to integrate into information generated for display to said user by a non-search application; wherein the set of sponsored content is selected based, at least in part, on said user specific data; and integrating said set of sponsored content within said information."

In rejecting Claims 17 and 26, the Office Action appears to rely on Emen's FIG. 3 which shows a single search engine 130 which displays results (step 98) through a browser 100 connected to that search engine 130. The Office Action appears to be asserting that Emen's single search engine 130 corresponds to the claimed "user specific data . . . collected using a search website". However, Emen's search engine 130 is never described as having anything to do with Emen's banner ads.

Additionally, Emens does not disclose or suggest "integrating said set of sponsored content within said information . . . generated for display by a non-search application" as recited at least within in Claims 17 and 26. Instead, Emens explicitly discloses the result presentation manager 160 builds a results page and sends this results page to the browser 100 (at step 99) (Emens, col. 7, lines 37-46). However, Emen's results page is part of Emen's original search

website, and thus cannot be characterized as “generated for display by a non-search application” as claimed.

Further, it is not possible to rely upon the banner ads described in Emen’s col. 1, lines 18-21 to anticipate this feature, as Claims 17 and 26 explicitly recite “user specific data <being> collected using a search website that provides searching functionality”. Although Emen’s banner ads can rely on user profiling (col. 1, line 25), Emen gives no indication that this user profiling is obtained “using a search website that provides searching functionality” as claimed. In fact, Emen explicitly describes such a feature as being undesired, suggesting that user profiling is burdensome to employ (col. 1, lines 25-26), and later suggesting that user profiles “need not be relied upon” (col. 5, line 18).

For at least the above reasons, the rejections of Claims 17 and 26, as well as all claims dependent therefrom, are invalid and should be withdrawn.

The Office Action (page 3, section 8) accorded no patentable weight to Claims 21, 22, 30, and 31. Although Applicant disagrees with this position, these claims have been amended and should be granted the examination to which they have always been entitled.

The Office Action (page 4, section 12) rejects Claims 24 and 33 under 103 as being suggested by the combination of Emen and McElfresh (Office Action, page 4, section 15).

However, McElfresh’ constraints (col. 6, lines 60-65) do not suggested the claimed “same design, motif, organization, or layout as other text on said website”. First, McElfresh’s constraints do not discuss knowing anything about the environment upon which they will be displayed, indeed do not acknowledge the original display or foundation display whatsoever.

Additionally, McElfresh' constraints on positions or demographics are described in the context of limitations on display techniques related primarily to contractual obligations (col. 6, lines 60-67).

In stark contrast, Applicant's use of the same "design, motif, organization, or layout as other text" for the purpose of blending, balance, and appearing similar to the theme of the website that a user is currently viewing (Applicant's specification, page 9, lines 20-22). Consequently, the two concepts are unrelated, and the rejection is invalid.

For at least the above reasons, the rejection of Claims 17 and 26, as well as all claims dependent therefrom, are invalid and should be withdrawn.

All remaining claims were rejected under 35 U.S.C. § 103 as allegedly obvious over a variety of references using Emens as a base reference. However, all of these claims either explicitly recite or depend from other claims which recite elements or steps which as shown above are neither disclosed nor suggested by any combination of prior art, either by Emens or by any other reference. The secondary references do not cure this deficiency of Emens, and therefore any combination of Emens with any of the secondary references cannot provide the complete combination of features recited in the remaining claims.

///

///

///

The Examiner is respectfully requested to contact the undersigned by e-mail or telephone if it is believed that such contact would further the examination of the present application. As per MPEP Chapter 5, Applicant understands that Internet communications may not be secure.

Please charge any shortages or credit any overages to Deposit Account No. 50-1302.

Respectfully submitted,

Hickman Palermo Truong & Becker LLP

/christophermtanner#41518/

Dated: May 22, 2008

Chris Tanner
Reg. No. 41,518

ctanner@hptb-law.com
2055 Gateway Place, Suite 550
San Jose, California 95110-1089
Telephone No.: (408) 414-1238
Facsimile No.: (408) 414-1076